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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,157	01/29/2001	Edward F. Tokas	IR-2588(ET)CIP	8701

7590 07/26/2005

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,157

Applicant(s)

TOKAS ET AL.

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33, 49 and 50 is/are pending in the application.
4a) Of the above claim(s) 6, 8, 21-33 and 49 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5, 7, 10-20 and 50 is/are rejected.
7) ☒ Claim(s) 9 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 6, 8, 21-33 and 49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made without traverse in the replies filed on 12-12-2003 and 7-28-2004.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-5, 10, 16-20 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 7-188636 to Nippon Zeon taken in view of EP 424833 to Goodall et al.

These references are applied for substantially the same reasons as set forth in the last office action with the exception that the amendment to claim 1 now defines over bonding to a second substrate using an adhesive unrelated to the metathesizable material and its curing. However, it is noted that JP '636 also indicates that the norbornene based resin member itself can additionally include an elastomer therein (note [0029] of the previously supplied machine translation of this reference). When taken together with fibrous fillers (as noted in the last office action), the included elastomer within the molded norbornene based resin member can be termed a "second substrate" which would be bonded to the fibrous filler during the metathesis polymerization. The claims do not define over such an interpretation.

4. Claims 1-5, 7, 10, 16-20 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 5,137,785) taken in view of EP 424833 to Goodall et al.

These references are applied for the same reasons as set forth in the last office action, it being again stressed that Suzuki et al. discloses bonding a norbornene based resin substrate member formed by metathesis polymerization to surface layers of an olefin polymer or thermoplastic elastomer (e.g. note col. 2, lines 9+), it again being considered that the obvious inclusion of fibrous fillers therein would provide a process in which the fibers are bonded to the surface layers via the surrounding metathesis polymer - it is not seen what in the present claims defines over such an interpretation.

5. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over [JP 7-188636 to Nippon Zeon taken in view of EP 424833 to Goodall et al.] or [Suzuki et al. (US 5,137,785) taken in view of EP 424833 to Goodall et al.] as applied above, and further in view of the admitted state of the prior art as applied in the last office action.

6. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Note the last office action.

7. Applicant's arguments filed 4-22-2005 have been fully considered but they are not persuasive principally for the reasons of record as well as those noted within the statements of rejection above.

The 35 USC 112 rejections have however been withdrawn in light of applicant's response.

As to the rejection based upon JP '636, applicant correctly points out that the adhesive in this reference is not the metathesizable material and it is agreed that the

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amendments to the claims overcome the previous application of this reference. Note however (as noted in the statement of rejection above) that JP '636 indicates that the norbornene based resin member itself can additionally include an *elastomer* therein (note [0029] of the previously supplied machine translation of this reference). When taken together with fibrous fillers (as noted in the last office action), the included elastomer within the molded norbornene based resin member can be termed a "second substrate" which would be bonded to the fibrous filler during the metathesis polymerization. The claims do not define over such an interpretation. Further, contrary to applicant's argument, it is considered that EP '833 would have been seen as applicable to reinforced molded norbornene based resin members as for example in JP '836.

The arguments that Suzuki et al. bonds a preformed norbornene sheet are unconvincing, it being stressed that this reference effects the metathesis polymerization at the same time that the bond to the surface layers forms (esp. col. 6, lines 21+). In such case, again, included fibrous filler can be described as bonded to the surface substrate layers via the metathesis polymer and applicant has not convincingly shown otherwise.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

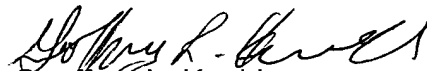
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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
July 25, 2005